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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,481	08/29/2000	Curtis Wong	MS155614.1	8554

27195 7590 06/26/2007  
AMIN. TUROCY & CALVIN, LLP  
24TH FLOOR, NATIONAL CITY CENTER  
1900 EAST NINTH STREET  
CLEVELAND, OH 44114

EXAMINER

SHANG, ANNAN Q

ART UNIT	PAPER NUMBER
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2623

MAIL DATE	DELIVERY MODE
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06/26/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/650,481

Applicant(s)

WONG ET AL.

Examiner

Annan Q. Shang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/19/07 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

With respect to Claims 1-4, 7-9, 13, 16, 18-19, 20-23, 25 and 26 rejected under 35 U.S.C. 102(e) as being anticipated by **Hirata (6,374,406)** and Claims 5-6, 10-12, 14-15, 17, and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Hirata, Applicant amends claims and argues that the prior art of record, Hirata does not teach the amended claim limitations, i.e., "...the schema comprising a multilevel data structure with a plurality of different fields for holding a plurality of data types...", "...fields that contain program criteria...", etc., (see page 6+ of Applicant's Remarks).

In response, Examiner disagrees. Examiner notes Applicant's arguments, however, Hirata discloses transmitting electronic mail data "a schema or multi-level data structure," over a network where the e-mail data holds control commands to reserve a

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recording, identifies a specific recording device, program and enables recording of the program on a specific device (col. 5, lines 14-35 and 55-64). Although Hirata's does not explicitly use the word "schema," which Applicant defines as data structure or multi-level data structure with a plurality of different fields for holding different types of data, etc., the fact remains that Hirata's e-mail data structure is a multi-level data structure, specifies fields or column and row locations for date, channel, time, etc., where each field performs a specific function. Furthermore these fields when extracted, enables a specific program to be recorded, on a specified date, channel, time, speed, etc. Hirata's e-mail data structure holds date data (identifies the year, month and day); channel data (identifies channels) and time data (identifies a start time, an end time). Hirata further discloses that the e-mail data can perform multiple video reservations (fig. 10, col. 6, lines 40-55, col. 7, lines 11-45 and col. 9, lines 5-13). The e-mail data structure, which is transmitted over a network, is functionally equivalent to the token as claimed, travels between devices, identifies a device and a specific program to be recorded, the channel, date, time, speed, etc., and performs the necessary recording of the program based on the stored data structure or fields, performing one or more functions. Hence the amended limitations of the claims, do not overcome the prior art of record. The amendment to the claims necessitated the new ground(s) of rejection discussed below.

**This office action is non-final.**

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4,7-9,13,16,18-19,20-23,25-26 rejected under 35 U.S.C. 102(e) as being anticipated by **Hirata (6,374,406)**, cited by examiner.

As to claim 1, **Hirata** discloses a system for controlling an electronic device via a control command signal contained in an electronic mail message “a token having a schema...” **Hirata** particularly discloses terminals that can be connected locally to a LAN or across the Internet (col.5, ln.31-35). **Hirata** also particularly discloses passing parameters within the email for recording a video program (col.5, ln.55-64), the schema comprising a multi-level data structure with a plurality of different fields for holding a plurality of data types, note that the e-mail data, holds date data (year, month and day), channel data (identifies channels), time data (start time and end time) and speed data (fig.10, col.6, lines 40-55, col.7, line 11-45 and col.9, lines 5-13) all of which perform different functions which meets the limitation “...multi-level data structure with a plurality of different fields for holding a plurality of data types or the program criteria...” as claimed.

As to claim 2, the claimed operative association between the token and message component is met by the references disclosure of the email transmission to reserve a recording on the video deck (col. 5 ln. 14-17).

As to claim 3, the claimed "text email message" is met by the text within the email body in Figure 3.

As to claim 4, the claimed "elements identifying sufficient characteristics of the corresponding program" to record the program is met by the date, time and channel parameters within the email (col. 5 ln. 50-54).

As to claim 7, the claimed computers not having a direct connection is met by the indirect connection (across the Internet) of the terminals of Figure 3.

Claim 8 is met by that discussed above for claim 1.

As to claim 9, the claimed text component operatively associated to the message component is met by the control command text in the body of the email (fig. 3).

Claim 13 is met by that discussed above for claim 4.

As to claim 16, Hirata discloses an email message (fig.3) and an operatively associated token (in this case, a control command signal), including program criteria (col. 5 ln. 51-54 & 6064).

As to claim 18, the claimed email message addressed "to an address associated with a remote computer and sending the message" is met by the email of Figure 3 and the terminals 1-1 and 1-4 in Figure 1 (col. 5 ln. 14-17).

As to claim 19, the claimed program criteria containing sufficient characteristics to record the program is met by the time, date, and channel criteria within the control command string (col.5 1n.55-64).

Claim 20 is met by that discussed above for claim 1.

Claim 21 is met by that discussed above for claim 19.

Claim 22 is met by that discussed above for claim 1.

Claim 23 is met by that discussed above for claim 19.

Claim 25 is met by that discussed above for claim 18.

Claim 26 is met by that discussed above for claim 19.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5-6,10-12,14-15,17,24 rejected under 35 U.S.C. 103(a) as being unpatentable over Hirata.

As to claim 5, **Hirata** discloses everything, as described above, except the "universal program identifier". However the examiner gives official notice that it is notoriously well known in the art of video recording to use a universal program identifier for the purpose of identifying a program for recording.

Therefore it is submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the universal program identifier to identify a program for recording for the purpose of minimizing the need to remember the time and channel of a particular program for recording.

As to claim 6, the claimed inclusion of "a plurality of program characteristics that identify different aspects of the corresponding program" is met by the program date, time and channel parameters passed in the email (col.5 1n.50-54).

As to claim 10, the reference discloses everything, as described above, except the inclusion of the token in an attachment to the email. However the examiner gives official notice that it is notoriously well known in the art of electronic mail to use an attachment for the purpose of transporting executable commands.

Therefore it is submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an attachment to transport the control command string for the purpose of separating executables from the text portion of messages.

As to claim 11, the reference discloses discrete computer terminals and addressing the message to the client (fig.3) as claimed. As to the client receiving the email from a server, the client/server relationship is inherent within the email protocols used over the Internet.

As to claim 12, the reference particularly discloses the use of a text email message (fig.3).

Claim 14 is met by that discussed above for claim 5.



As to claim 15, the claimed "plurality of program characteristics that identify different aspects of the corresponding program" is met by the date, time and channel parameters within the email (col.5 1n.50-54).

Claim 17 is met by that discussed above for claim 10.

Claim 24 is met by that discussed above for claim 10.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

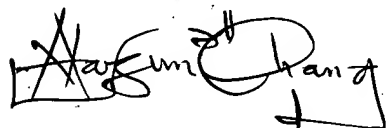
Yukie et al (6,956,833) disclose method, system and devices for wireless data storage on a server and data retrieval.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC) at 866-217-9197 (toll-free)**. If you would like assistance from a **USPTO Customer Service Representative** or access to the automated information system, call **800-786-9199 (IN USA OR CANADA)** or **571-272-1000**.

A handwritten signature in black ink, appearing to read 'Annan Q. Shang', with a stylized flourish at the end.

**Annan Q. Shang**